



If one assumes that Figure 1 does show a suit as the Examiner stated, then the apparent suit of the card of Figure 1 should be a club. However the suit of the card shown in Figure 2 is a spade, an entirely different suit. Applicant's invention discloses only one suit for each card (the card's suit) that is displayed when the card is first dealt to allow a number of new card games to be played based on knowing only one of the card's two indicia, e.g. the card's suit and not the card's rank. If a player were dealt the card of Needler's Figure 1 and Figure 2 with the card back shown in Figure 1 visible, he would not have any knowledge of the card's suit OR the card's rank because the card back shows a club, while the card's front shows any of the four suits.

By contrast, Applicant's invention has no such ambiguity because there is no second suit associated with a card. A player playing a video poker game of Claims 5 or 19 having been dealt a first card would have knowledge of the ONLY suit associated

with that card. Specifically, for the ace of spades, a player playing the video poker game of Claims 5 or 19 could only see a spade, and not a club as shown in Needler's Figure 1 and 2. There is no way to resolve the ambiguity of Needler's Figure 1 and Figure 2 with the rules of poker. Thus Needler's Figures 1 and 2 teach away from Applicant's invention,

Therefore, Applicant respectfully requests that the rejection of Claims 5 and 19-21 under 35 U.S.C. § 103(a) as being unpatentable over Needler (592) be withdrawn.

#### **New Examination Guidelines for Determining Obviousness**

Recent changes to Examination Guidelines for Determining Obviousness Under 35 U.S.C 103 in view of the KSR decision require the Examiner to reconsider the rejection of independent Claims 5 and 19 using Needler and known playing cards in the context of these new guidelines.

The new guidelines set out seven rationales to support rejections under 35 U.S.C 103: (A) combining prior art elements according to known methods to yield predictable results; (B) simple substitution of one known element for another to obtain predictable results; (C) use of known technique to improve similar devices (methods, or products) in the same way; (D) applying a known technique to a know device (method or product) ready for improvement to yield predictable results; (E) "Obvious to try"; (F) known work in one field may prompt variation of it for use in either the same or a different field; and (G) some teaching, suggestion, or motivation in the prior art that would have led one of ordinary skill to modify the prior art reference or combine prior art

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reference teachings to arrive at a claimed invention. Each of these rationales is discussed individually below, and none support the obviousness rejection.

(A) Combining prior art elements according to known methods to yield predictable results. As stated in the Guidelines, "The rationale to support a conclusion that the claim would have been obvious is that all the claimed elements were known in the prior art and one skilled in the art could have combined the elements as claimed by known methods with no change in their respective functions, and the combination would have yielded nothing more than predictable results to one of ordinary skill in the art at the time of the invention." (Guidelines, Section IIIA)

For Applicant's inventions, the Examiner has combined Needler's cards back with known playing cards. However, this combination does not meet the above quoted rationale because Needler's cards have a single design on the back for all cards in the deck. For Needler's cards to be adapted to Applicant's invention would require a fundamental change to the function of Needler's cards' back from being an ornamental design (Needler's patent is a design patent) to indicating the same suit as appears on the front side (see Needler Figs 1 and 2 above). In particular,  $\frac{3}{4}$  of Needler's cards would need to be changed. Such a change would directly contradict the guideline above for "no change in their respective functions." Therefore, combining prior art elements according to known methods using Needler and known playing cards cannot be used to support a conclusion of obviousness.

(B) Simple substitution of one known element for another to obtain predictable results. As stated in the Guidelines, "The rationale to support a conclusion that the claim would have been obvious is that the substitution of one known element for

another would have yielded predictable results to one of ordinary skill in the art at the time of the invention.” (Guidelines, Section IIIB)

Substitution of Needler’s card back for an ordinary card back fails to meet the above quoted rationale because a substitution of Needler’s card back would not yield the game play recited in Claims 5 and 19. Needler’s card back has a single design for the entire deck – the predictable result of such a substitution would be the display of the incorrect suit for three fourths of the cards in a known deck with “clubs” being the only correctly displayed suit when the cards are first dealt. By contrast, the initial display as recited in Claims 5 and 19 would not be a predictable result of Needler’s card back, because Needler fails to disclose different suits for different cards in the deck. Substituting Needler into an “ordinary” deck of cards yields a simple and entirely predictable result - an ordinary deck of cards. Therefore, substituting Needler’s card back for an “ordinary” card back cannot be used to support a conclusion of obviousness.

(C) Use of known technique to improve similar devices (methods, or products) in the same way. As stated in the Guidelines, “The rationale to support a conclusion that the claim would have been obvious is that a method of enhancing a particular class of devices [methods or products] was made part of the ordinary capabilities of one skilled in the art based upon the teaching of such improvement in other situations.” (Guidelines, Section IIIC)

The Examiner has relied on a combination of Needler and ordinary cards (which, as explained above, is internally inconsistent because Needler’s deck is an ordinary deck of cards). Needler fails to disclose “other situations” for use of his cards because his patent is a design patent. As discussed above, Needler also fails to show the

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enhancement needed to result in the invention of Applicant's Claims 5 and 9. Therefore, the combination of Needler's technique does not include sufficient enhancements or teach any improvement in known cards that would result in Applicant's Claims 5 and 19.

(D) Applying a known technique to a known device (method or product) ready for improvement to yield predictable results. As stated in the Guidelines, "The rationale to support a conclusion that the claim would have been obvious is that a particular known technique was recognized as part of the ordinary capabilities of one skilled in the art." (Guidelines, Section IIID)

As stated above, the Examiner's use of Needler's cards fails to predict the features of Claims 5 and 19, specifically the display of different suits for different cards when initially dealt. Therefore, this rationale cannot be used to support a conclusion of obviousness.

(E) "Obvious to try". As stated in the Guidelines, "The rationale to support a conclusion that the claim would have been obvious is that 'a person of ordinary skill has a good reason to pursue the known options within his or her technical grasp.'" (Guidelines, Section IIIE)

There is nothing in Needler's design patent that suggests the features of Applicant's methods – specifically displaying the card's suit when initially dealt (as opposed to Needler's card back), and then showing the card's suit and rank when the card is selected. As explained above,  $\frac{3}{4}$  of Needler's cards would have to be totally redesigned, making them totally different from Needler's design patent. This is not evidence of an "obvious to try" solution. Therefore, "obvious to try" cannot be used as a rationale to support a conclusion of obviousness.

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(F) Known work in one field may prompt variation of it for use in either the same or a different field. As stated in the Guidelines, “The rationale to support a conclusion that the claimed invention would have been obvious is that design incentives or other market forces could have prompted one of ordinary skill in the art to vary the prior art in a predictable manner to result in the claimed invention.” (Guidelines, Section IIIF)

For reasons stated above, Needler cannot be used in a predictable manner to result in invention of Claims 5 and 19. Therefore, known work prompting a variation for use cannot be used as a rationale to support a conclusion of obviousness.

(G) Some teaching, suggestion, or motivation in the prior art that would have led one of ordinary skill to modify the prior art reference or combine prior art reference teachings to arrive at a claimed invention. As stated in the Guidelines, “The rationale to support a conclusion that the claim would have been obvious is that ‘a person of ordinary skill in the art would have been motivated to combine the prior art to achieve the claimed invention and that there would have been a reasonable expectation of success.’” (Guidelines, Section IIIG)

The Examiner has not cited any other prior art beside Needler and ordinary cards to arrive at the invention of Claims 5 and 19. As shown above, the combination of Needler and ordinary cards fails to disclose all of the requisite features of Claims 5 and 19. Therefore, the Examiner has failed to disclose any teaching, suggestion or motivation in the prior art that would result in Applicant’s Claims 5 and 19, and teachings, suggestions, and motivations in the prior art cannot be used as a rationale to support a conclusion of obviousness.

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### Conclusion

In view of the foregoing amendment and remarks, and for at least the reasons discussed above, Applicants respectfully submit that the claims are allowable. Their favorable reconsideration and allowance are respectfully requested.

The Examiner is invited to telephone the undersigned to discuss any still outstanding matters with respect to the present application.

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Respectfully submitted,

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